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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,366	08/06/2003	Jeffrey M. Vitullo	3600/268	1298
1912 7590 03/05/2009 AMSTER, ROTHSTEIN & EBENSTEIN LLP 90 PARK AVENUE NEW YORK, NY 10016				
EXAMINER DESANTO, MATTHEW F				
ART UNIT 3763		PAPER NUMBER		
MAIL DATE 03/05/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/635,366

**Applicant(s)**

VITULLO ET AL.

**Examiner**

MATTHEW F. DESANTO

**Art Unit**

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (USPN 4,645,491) in view of Houser et al. (USPN 5,569,221) and Benjamin (USPN 6,245,053).

Evans discloses a catheter (21) with a proximal section, a body and a distal section that is inserted into a needle (20) with a hub (22), but fails to disclose the specific location of the stiffening section, the specific size of the catheter and how the process of making the stiffening section.

Houser et al. discloses a catheter and method of making a catheter with a reinforcing member (16+20) that is enclosed within a sleeve (22) so that the catheter has a reinforced member, which provides a stiffening section (Figure 1-3, 8 and entire reference). Houser et al. also discloses the specific wall thickness and the benefit of using a thin wall thickness (column 3) as well as the specific material of the sleeve (column 3).

Benjamin discloses a catheter and a method of making stiffening sections in the catheter, wherein the stiffening section is located 10 to 15 cm from the

distal end (Column 10-37) and also discloses similar methods of making the stiffening section as well as using similar polymers/materials for the catheter.

Therefore, at the time of the invention it would have been obvious for one of ordinary skill in the art to combine the device of Evans with the teachings of Houser et al. and Benjamin because Houser et al. disclosed the benefit of using a reinforced element in a catheter because of the stronger bond as well as the reinforced section which allows the catheter to have an improved flexible bond (Houser Column 1, lines 40-55) at the distance taught by Benjamin since Benjamin discloses the benefit of having a soft distal tip with a reinforced section proximally the distal tip in order to provide greater maneuverability (col. 3 & 4).

The examiner would also like to note that Houser et al. and Benjamin both teach several well known techniques and polymers to make a stiffening section. It would also have been obvious to modify the size of the catheter and section of the stiffening section because of the ranges that are taught in Houser et al. and Benjamin for the diameter and size of the catheters.

#### ***Response to Arguments***

3. Applicant's arguments, filed 08/28/08, are moot because of the new grounds of rejection as well as the further evidence to show the level of skill in the art.
4. The examiner would like to note that changing size and diameter of a catheter in the medical art is well known and only takes routine skill in the art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance call 800-786-9199 (IN USA) or 571-272-1000.

Matthew DeSanto

/Matthew F DeSanto/  
Primary Examiner, Art Unit 3763